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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/738,355	12/16/2003	Rodney J. Clements	10617	7570

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EXAMINER

GARCIA, ERNESTO

ART UNIT	PAPER NUMBER
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3679

DATE MAILED: 04/25/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/738,355

Applicant(s)

CLEMENTS ET AL.

Examiner

Ernesto Garcia

Art Unit

3679

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 December 2003 and 16 April 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) 1-11 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 12-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 16 April 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>12/16/03</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Restriction

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-11, drawn to a hidden fastening system, classified in class 52, subclass 288.1.
- II. Claims 12-23, drawn to a receptacle or a coupler, classified in class 403, subclass 403.

The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention II has separate utility such as connecting two handrails. See MPEP § 806.05(d).

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

During a telephone conversation with Mr. R. Michael West on April 15, 2005 a provisional election was made without traverse to prosecute the invention of Group II,

Art Unit: 3679

claims 12-23. Applicant in replying to this Office action must make affirmation of this election. Claims 1-11 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Drawings

The drawings are objected to because the drawings do not comply with rule CFR 1.121. Any replacement drawing sheet must be identified in the top margin as "Replacement Sheet".

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended". If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement

sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the examiner does not accept the changes, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Objections

Claims 12, 20 and 23 are objected to because of the following informalities:
regarding claim 12, --respectively-- should be inserted after "cavity" in line 5, and --to be-- should be inserted after "trim" in line 7;
regarding claim 20, --to be-- should be inserted after "trim" in line 3; and,
regarding claim 23, "receptacle" should be --coupler--. Appropriate correction is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

Art Unit: 3679

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 12-16 and 18-22 are rejected under 35 U.S.C. 102(b) as being anticipated by Nelson, 3,405,488 (see marked-up attachment).

Regarding claim 12, Nelson discloses, in Figure 7, a receptacle comprising a first receiver **A21**, a second receiver **A24**, and a juncture **A27**. The first receiver **A21** and the second receiver **A24** each have an open outer end **A22** and an inner end **A23**. The juncture **A27** is between the inner end **A23** of the first receiver **A21** and the inner end **A23** of the second receiver **A24**. The first receiver **A21** and the second receiver **A24** each have an internal cavity **A28** --respectively-- extending from the open outer end **A22** to the inner end **A23**. Applicant is reminded that the internal cavity **A28** is sized and configured to accommodate and cover an end portion of a piece of molding or trim -to be-- inserted therein.

Regarding claim 13, the juncture **A27** comprises an outside corner (Figure 6). The first receiver **A21** and the second receiver **A24** have axes maintained at 90, 120 or 135 degrees with respect to each other.

Regarding claim 14, the juncture **A27** comprises an inside corner (Fig. 7). The first receiver **A21** and the second receiver **A24** have axes maintained at 90, 120 or 135 degrees with respect to each other.

Regarding claim 15, the first receiver **A21** and the second receiver **A24** include retaining means **26**. Applicant is reminded that the retaining means 26 can secure molding or trim to the receptacle without the use of fasteners or adhesives.

Regarding claims 16 and 22, the retaining mean comprises an upper lip **26** and a lower through **26**.

Regarding claim 18, the first receiver **A21** and the second receiver **A24** define respective planes which are oblique with respect to each other (col. 4, lines 39-40).

Regarding claim 19, applicant is reminded that the recitation that an element is "adapted to" perform a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchison*, 69 USPQ 138. Therefore, the first receiver **A21** and the second receiver **A24** can be adapted to receive crown molding or trim.

Regarding claim 20, Nelson discloses, in Figure 7, a coupler comprising a first receiver **A21** and a second receiver **A24**. The first receiver **A21** and the second receiver **A24** each is sized and configured to accommodate and cover an end portion of a piece of molding or trim --to be-- inserted therein.

Regarding claim 21, the first receiver **A21** and the second receiver **A24** include retaining means **26**. Applicant is reminded that the retaining means 26 can secure molding or trim to the receptacle without the use of fasteners or adhesives.

Claims 12, 15-17, and 20-23 are rejected under 35 U.S.C. 102(b) as being anticipated by Woods, 3,074,521 (see marked-up attachment).

Regarding claim 12, discloses, in Figure , a receptacle comprising a first receiver **79**, a second receiver **81**, and a juncture **A27**. The first receiver **79** and the second receiver **81** each have an open outer end **A22** and an inner end **A23**. The juncture **A27** is between the inner end **A23** of the first receiver **79** and the inner end **A23** of the second receiver **81**. The first receiver **79** and the second receiver **81** each have an internal cavity **79,81** --respectively-- extending from the open outer end *** to the inner end **A23**. Applicant is reminded that the internal cavity **79,81** is sized and configured to accommodate and cover an end portion of a piece of molding or trim --to be-- inserted therein.

Regarding claims 15 and 21, the first receiver **A21** and the second receiver **A24** include retaining means **97,99**. Applicant is reminded that the retaining means **97,99** can secure molding or trim to the coupler without the use of fasteners or adhesives.

Regarding claims 16 and 22, the retaining mean comprises an upper lip **10** and a lower through **87**.

Regarding claim 17 and 23, the retaining means **97,99** comprises at least one rib.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ernesto Garcia whose telephone number is 571-272-7083. The examiner can normally be reached from 9:30-5:30. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9326 for regular communications and 703-872-9327 for After Final communications.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Daniel P. Stodola can be reached on 571-272- 7087. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR.

Art Unit: 3679

Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should

you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free).



E.G.

April 15, 2005

Attachments: one marked-up page of Nelson, 3,405,488; and,
one marked-up page of Woods, 3,074,521.

DANIEL P. STODOLA
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600